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Elizabeth A. Colbert

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/625,624
Filing Date: July 24, 2003
Appellant(s): COLBERT, ELIZABETH A.

Michael Britton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 6, 2009, appealing from the Office action mailed July 28, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,105,325	ZUBER et al.	8-2000
4,287,103	FRANCIS et al.	9-1981

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-19 and 32-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 4,287,103) in view of Zuber et al. (US 6,105,325). Francis et al. disclose wallboard comprising a gypsum core sandwiched between paper facings (col 1, ln 9-10), wherein the paper facing is coated with a joint composition (col 1, ln 17-26). The joint composition comprises filler material, adhesive binder, and water. As seen in Table 1, water is present in the composition in the amount of 33.5-35.5% by weight. The preferred filler is gypsum or limestone (i.e. calcium carbonate) (col 5, ln 19-25) in the amount of 25-93% by weight (col 5, ln 21). Mica or talc are also added to the composition (col 4, ln 42) in the amount of 5-50%. The binder, which is latex (see col 2, ln 60), is present in the amount of 2-12% by weight. It should be noted that in claim 6 of the present invention, filler (**0-30%**) and additives (**0-10%**) are being treated as optional components since they can be present in the composition in the amount of **0%**. Also, in claim 9, limestone (**0-50%**), clay (**0-10%**), other fillers (**0-30%**), and additives (**0-10%**) are being treated as optional components since they can be present in the composition in the amount of **0%**. Francis et al. disclose the claimed invention except for the specific teaching that the gypsum board is precoated with a coating during manufacture. Francis et al. also fail to teach that the coating penetrates through at least a portion of the facing sheet and into the gypsum core. Finally, Francis et al. fail to disclose that the composition comprises a pigment material and that the paper is an unbleached grey paper.

Zuber et al. (US 6,105,325) disclose a plasterboard material comprising a plaster body and at least one sheet of lining paper (i.e. facing) comprising a mineral filler of light color (abstract). The abstract specifically states that the joint-pointing coat jointing said plasterboards forms a substantially plane outer surface. It is the Examiner's position that the coating forming a "substantially plane outer surface" can be properly equated to Applicant's "coating disposed on an entirety of the facing sheet." The pigment layer comprises a white mineral filler (col 3, ln 60-63). As seen in Zuber at column 3, lines 58-67, the pigment layer covers the facing sheet. In addition, one of the sheets of paper can be unbleached grey paper (col 3, ln 25-28). Zuber et al. also disclose assembling a plasterboard with at least a joint coat (claim 1) which can be equated to Appellant's limitation that the gypsum board is precoated during manufacture. As seen in claim 1 of Zuber, a joint-pointing coat jointing composition forms an outer surface. Therefore, Zuber can be considered to be a wet sheet and as a result, has the same process conditions claimed by Appellant. It would have been obvious to one having ordinary skill in the art to have used Zuber's method of precoating the gypsum board during manufacture on the wallboard of Francis, motivated by the desire to create a wallboard with cheaper processing costs and to create a wallboard that is relatively uniform.

It would have been obvious to one having ordinary skill in the art to have used the pigment of Zuber in the composition of Francis, motivated by the desire to create a joint composition that has the desired tint. It also would have been obvious to one having ordinary skill in the art to have made the paper of Francis be the unbleached grey paper of Zuber, motivated by the desire to create a wallboard material that has cheaper manufacturing costs, due to not bleaching the paper.

It also would have been obvious to one having ordinary skill in the art to have the joint composition of Francis and Zuber penetrate through the paper and into the gypsum core, motivated by the desire to create a wallboard material that has increased lamination strength and tear resistance. Because the same materials are being used as the facing sheet (paper) and coating (joint compound), the coating would penetrate therethrough.

Regarding claims 3 and 4, Francis et al. and Zuber et al. do not disclose the specific coating thickness. However, in the absence of unexpected results it would have been obvious to one having ordinary skill in the art to have made the thickness of the coating up to 30 mils or preferably 3-20 mils, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In the present invention, one would have optimized the coating thickness motivated by the desire to create a wallboard material that has decreased delamination and increased strength.

Regarding claims 12, 13, 15, 18, although Francis and Zuber do not explicitly teach the claimed level 4 or level 5 finish, it is reasonable to presume that this property is inherent to the invention of Francis and Zuber. Support for said presumption is found in the use of like materials (i.e. gypsum board, paper facing, and a coating comprising water, gypsum or limestone, latex binder, clay or mica or talc, and other additives) and the use of like processes (i.e. coating the gypsum board during manufacture). The burden is upon Appellant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of a facing sheet with a

level 4 or level 5 finish, would obviously have been present once the Francis and Zuber product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

Regarding claims 32-39, it should be noted that the method of forming an article is not germane to the issue of patentability of the device itself. Furthermore, it would have been obvious to one having ordinary skill in the art to have applied the precoating either before or after the board is passed through a drying oven, motivated by the desire to obtain a wallboard that has a uniform appearance.

(10) Response to Argument

Appellant argues that Francis does not teach an entirety of a paper facing coated with a joint composition. It appears as though Appellant is attacking the references individually in a 103 rejection. It should be noted that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on a combination of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). The rejection is a 103 rejection over Francis et al. in view of Zuber et al. It should be noted that the Zuber et al. reference discloses a jointing coat that covers the outer surface (abstract).

Appellant also argues that the coating in Zuber does not cover the entirety of the facing sheet. However, the abstract of Zuber specifically states that the joint-pointing coat jointing said plasterboards forms a substantially plane outer surface. It is the Examiner's position that the coating forming a "substantially plane outer surface" can be properly equated to Applicant's "coating disposed on an entirety of the facing sheet."

Appellant also argues that Zuber's joint coat is not equivalent to precoating the board during manufacture. Zuber et al. also disclose assembling a plasterboard with at least a joint coat (claim 1) which can be properly equated to Appellant's limitation that the gypsum board is precoated during manufacture. As seen in claim 1 of Zuber, a joint-pointing coat jointing composition forms an outer surface. Therefore, Zuber can be considered to be a wet sheet and as a result, has the same process conditions claimed by Appellant.

Appellant argues that neither reference teaches a coating penetrating into a gypsum core. This argument is not persuasive because, as shown above, it would have been obvious to one having ordinary skill in the art to have the joint composition of Francis and Zuber penetrate through the paper and into the gypsum core, motivated by the desire to create a wallboard material that has increased lamination strength and tear resistance. Because the same materials are being used as the facing sheet (paper) and coating (joint compound), the coating would penetrate therethrough, as broadly claimed.

Finally, Appellant argues that the claim features result not only from certain elements used in the construction, but also from the methods disclosed in the specification by which the claimed boards are constructed and accordingly, the products result from a combination of the materials used and the methods by which they are assembled. This argument is not commensurate in scope with the present claims, which are drawn to product limitations, not process limitations. Furthermore, it is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Art Unit: 1794

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/U. C. R./
Primary Examiner, Art Unit 1794

Conferees:

/KEITH D. HENDRICKS/
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